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| 10/690,208      | 10/21/2003  | Mary E. McDonald     | MCD0003/US          | 2333             |

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EXAMINER

WEBB, GREGORY E

ART UNIT PAPER NUMBER

1751

DATE MAILED: 08/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/690,208

Applicant(s)

MCDONALD, MARY E.

Examiner

Gregory E. Webb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 020504.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Googin et al (US 5,207,838).

Googin teaches solvent compositions for cleaning metal surfaces contaminated with radioactive materials (see title and abstract).

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Concerning the radioactive contaminant, Googin teaches the following:

It will be seen that the relatively nontoxic and non-hazardous solvent compositions of the present invention provide degreasing and water chasing properties essentially as good as the toxic, hazardous, and ozone-depleting chlorinated and chlorofluorocarbon solvents heretofore utilized for cleaning surfaces of radioactive metals and alloys. By employing these halogen-free solvent compositions, which have flammability characteristics of greater than 140.degree. F. and thus not listed as hazardous under the RCRA, for cleaning of surfaces of radioactive materials any waste material resulting from the cleaning operation can be simply stored or processed as low-level radioactive waste.(see col. 8, lines 14-26)

Concerning the polar organic diluent, preferred diluent and the most preferred degreaser, Googin teaches the following:

10. A method for cleaning a metal surface as claimed in claim 7, wherein the polar solvent having a minimum flash point of 140.degree. F. is selected from the group consisting of 1-hexanol, N-methyl-2-pyrrolidinone, propylene glycol, propylene carbonate, N-ethylene glycol, diethylene glycol, triethylene glycol, diethylene glycol dimethyl ether, ethylene glycol monobutyl ether, tripropylene glycol monomethyl ether, tripropylene glycol dimethyl ether, dipropylene glycol monomethyl ether, diethylene glycol monobutyl ether, and mixtures thereof.(see claim 10)

Concerning the preferred degreaser, Googin teaches the following:

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The method for cleaning a metal surface for the removal of any organic contaminants, water, and aqueous residue comprises the steps of contacting the metal surface with a solvent composition that is substantially free of aromatic components and which consists essentially of a blend of a nonpolar aliphatic hydrocarbon solvent and about 2 to 25 volume percent of a polar solvent, and wiping from the metal surface substantially all of the solvent composition and any organic contaminants, water, and aqueous residue displaced from the metal surface by the solvent composition. In the solvent composition, the aliphatic hydrocarbon solvent is characterized by a major concentration of a hydrocarbon having at least eleven carbon atoms, a boiling point in a narrow boiling range in a temperature range of about 170.degree. to about 250.degree. C., a vapor pressure of at least 0.4 mm mercury at room temperature, and a minimum flash point of about 140.degree. F. The polar solvent in the solvent composition is selected from an alcohol, ether, pyrrolidone, carbonate, glycol, glycol ether, or a mixture thereof that is characterized by a sufficiently high polarity to displace water and aqueous residue from the metal surface and by possessing a flash point sufficiently high to provide the solvent composition with a minimum flash point of 140.degree. F. This method is especially suited for cleaning surfaces of radioactive material.(see cols. 3-4)

Concerning the degreaser groups, Googin teaches the following:

The aliphatic hydrocarbon solvent component of the solvent composition as

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provided by any of the above described aliphatic hydrocarbons or any of the commercially available solvents noted above is nonpolar and effectively dissolves oily and greasy films on surfaces of hard metals so that the surfaces can be wiped clean of the oily and greasy residue by employing a paper or cloth wipe in much the same manner as previously accomplished with the hazardous chlorinated or chlorofluorocarbon solvents. The aliphatic hydrocarbon solvent component evaporates from the wiped metal surfaces at a relatively slow rate which substantially corresponds to the evaporation rate of kerosene. The use of an aliphatic hydrocarbon solvent with an evaporation rate slower than about that of kerosene would probably be undesirable from a production standpoint for the cleaning of metallic surfaces.(see cols. 4-5)

Claims 1-25 are rejected under 35 U.S.C. 102(e) as being anticipated by McDonald (US 6,583,097).

McDonald teaches an universal cleaners containing degreasers and nonaromatic naptha and an alcohol acting as a diluent (see abstract).

Concerning the preferred degreaser, McDonald teaches the following:

The next group of tests showed that, of the glycol ethers, PnB did the least amount of damage to decals. Also, the test indicated that a preferred glycol ether content is between 5% and 10% by volume.

(see col. 20, lines 33-36)

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Concerning the preferred diluent and the preferred rubber solvent, McDonald teaches the following:

The liquids tested with this method included ethanol, hexanol, isopropanol, and hardware store naphtha. The ethanol, hexanol, and isopropanol dissolved the pencil lead better than the naphtha.(see example 7)

Concerning the most preferred degreaser, McDonald teaches the following:

13. The method of claim 12, wherein the glycol ether is selected from propylene glycol n-butyl ether, propylene glycol n-propyl ether, diethylene glycol monobutyl ether, ethylene glycol monobutyl ether, dipropylene glycol methyl ether, propylene glycol methyl ether, and combinations thereof.(see claim 13)

Concerning the degreaser groups, McDonald teaches the following:

A wide variety of rubber solvents are known and may be advantageously incorporated into cleaning compositions of the present invention.

Preferred rubber solvents belong to the class of hydrocarbon solvents and may be aliphatic, aromatic, straight chain, branched, linear, and/or cyclic. The suitable hydrocarbon solvents may comprise one or more hetero atoms and be substituted or unsubstituted. Representative examples of rubber solvents include one or more of toluene, benzene, xylene, C5 to C15 paraffins, cycloparaffins, an olefin, acetylene polymers, terpene polymers, isoprene polymers, turpentine, petroleum products such as gasoline, kerosene, petroleum distillate, naphtha, mineral spirits, and

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the like; and natural and/or synthetic hydrocarbons and/or oils such as mineral oil, vegetable oil, animal oil, essential oil, edible oils, combinations of these, and the like. Specific oils include fish oil, sperm oil, fish-liver oil, corn oil, safflower oil, soybean oil, cottonseed oil, palm oil, coconut oil; combinations of these, and the like.(see col. 4)

Concerning the applicant's specific contaminant, as McDonald teaches the composition to be a "universal" cleaner, such specific contaminants as radioactive materials would clearly fall within this category. The applicant has not demonstrated any particular efficacy of this composition to clean radioactive materials as opposed to any other material. Thus the prior art clearly encompasses the applicant's claimed intended use.



***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDonald '097) as applied to claims 1-25 above, and further in view of Googin et al (US 5,207,838).

4. McDonald fails to teach the specific use of their "universal" cleaner for removing radioactive contaminants. McDonald does however specifically teach their composition for removing the following soils: oil, tar, rubber, bug residue, and other soils (see col. 2, lines 20-26).

5. Googin is also concerned with the removal of oils and greases (see cols. 1, lines 19-45) from substrates. The oils and greases of Googin however contain traces of radioactive material (see cols. 1-2). Thus Googin's main concern is the removal of the oils and greases which become hazardous when traces of radioactive material are contained therein. Thus the bulk property of

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the soil would inherently match those of the non-radioactive soils taught by McDonald as the content of the radioactive materials do not control the properties of the soil being removed. As such it would be obvious based on Googin to use the compositions of McDonald either for contaminated or non-contaminated oily and greasy soils.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 14-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-19 of U.S. Patent No. 6,583,097. Although the conflicting claims are not identical, they are not patentably distinct from each other.

The applicant's claims differ from the prior art only in the intended use of the composition. Instant claim 14 is intended for hand cleaning whereas claim 1-19 of '097 are intended for universal cleaning of any substrate contaminated with any soil. As such the '097 patent broadly encompasses the applicant's specific intended use.

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***Conclusion***

Also of relevance as demonstrating the state-of-the-art in degreasing and contaminated soils are the following references: Martin (US 6,605,158), Martin (US 6,652,661), Nachtman et al (US 5,763,734), and Martin (US 6,497,769).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory E. Webb whose telephone number is 571-272-1325. The examiner can normally be reached on 9:00-17:30 (m-f).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Gregory E. Webb  
Primary Examiner  
Art Unit 1751

gew